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REMARKS

Applicant wishes to thank the Examiner for considering the present application. In the Office Action dated May 19, 2005, Claims 1-17 are pending in the application. Applicant hereby affirms the election of Claims 1-12 that are set forth in Group I by the Examiner.

Claims 1-12 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-12 of co-pending application number 09/844,923. Applicant has submitted a Terminal Disclaimer for the provisional rejection. Applicant respectfully submits that this rejection has now been overcome.

Claims 1-7 and 9-12 stand rejected as being unpatentable over *Hendricks* (6,160,989) in view of *Kim* (6,556,248). Applicant respectfully traverses.

Claim 1 is directed to a system of broadcasting digital channels during a vertical blanking interval. Claim 1 recites a satellite, a network operations center uplinking electronic content to the satellite, and a terrestrial over-the-air digital broadcast center receiving the electronic content from the satellite and generating digital over-the-air electronic content during a vertical blanking interval of an analog broadcast signal. The terrestrial over-the-air digital broadcast center generates the over-the-air electronic content over a vertical blanking interval of an analog broadcast signal. Claim 1 was amended to clarify that the over-the-air digital broadcast center is a terrestrial system.

The *Hendricks* reference is directed to network controller for cable television delivery systems. The *Hendricks* reference specifically mentions that the teachings may be applied to "home telephone lines, cellular networks, fiberoptics, Personal Communication Networks and similar technology for transmitting to the home" as set forth in Col. 7, lines 30-34. Applicant

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agrees that both a digital and analog tuner are illustrated as elements 3 and 5 of Fig. 2. Applicant agrees that an operations center satellite and a network controller are illustrated. However, as the Examiner sets forth, no broadcasting over a vertical broadcasting interval of an analog broadcast signal is taught in the *Hendricks* reference. The *Hendricks* reference also does not suggest a second portion an analog broadcast signal that is transmitted during the vertical blanking interval.

The *Kim* reference is set forth for a system that utilizes the vertical blanking interval of an analog broadcast system to deliver various data. Applicant agrees that the vertical blanking interval in *Kim* is used for various data. No teaching is provided for a terrestrial-based over-the-air broadcast center which then broadcasts the electronic content.

The Examiner states, "it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify the cable headend disclosed by *Hendricks* to be able to transmit some of the data or 'electronic content' within the VBI of an 'analog broadcast signal', as taught in *Kim*, in order to efficiently use the bandwidth available between the headend and user terminals thereby increasing the efficiency of the overall system." Applicant respectfully submits that the Examiner is forming a hindsight reconstruction of the present invention using the teachings of the prior art.

It is improper, in determining whether a person of ordinary skill in the art would have been led to this combination of references, simply to "[use] that which the inventor taught against the teacher." W. L. Gore v. Garlock Inc., 721 F. 2d 1540, 1553, 220 USPQ 301312-13 (Fed.Cir.1983). "Obviousness may not be established using hindsight or in view of the teachings or suggestions of the inventor." Para-Ordnance Mfg. V. SGS Importers Int'l, 73 F.3d at 1087, 37

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USPQ2d at 1239, citing W. L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d at 1551, 1553, 220 USPQ at 311, 312-13. Clearly, no support, motivation or incentive is provided by the two cited references for such a combination. It is well established that the prior art must make a suggestion of, or provide an incentive for a claimed combination of elements to establish a *prima facie* case of obviousness. See In re Oetiker, 24 U.S.P.Q.2d 1443, 1446 (Fed.Cir. 1992); Ex parte Clapp, 227 U.S.P.Q. 972, 973 (Bd. Pt. App. 1985). In this instance, however, no support, motivation, or incentive is provided by the two cited references for the combination proposed by the Examiner. The *Hendricks* reference is clearly used as a generic communication system. Only conventional broadcasting without extra content is set forth.

Claim 9 is similar to Claim 1 in method form. Claim 9 recites the steps of uplinking a plurality of electronic content packages to a satellite, receiving the electronic content packages from the satellite, over-the-air broadcasting of the electronic content packages during a vertical blanking interval of an analog television broadcast signal from a terrestrial over-the-air broadcast center and receiving electronic content packages through a user appliance. Thus, Claim 9 is similar to Claim 1 in that electronic content packages are provided during the vertical blanking interval of a television broadcast signal. The television broadcast signal is provided from a terrestrial over-the-air broadcast center.

Claims 2-7 and 10-12 are dependent upon independent claims 1 and 9. Applicant respectfully believes that these claims are also allowable for the same reasons set forth above.

Claim 8 stands rejected under 35 U.S.C. §103(a) as being unpatentable over *Hendricks* in view of *Kim* in further view of *Owa* (6,711,397). The *Owa* reference also does not teach or

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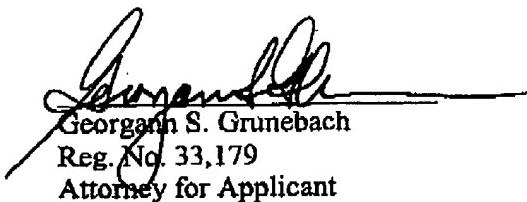
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suggest the combination set forth by the Examiner. Applicant respectfully believes that these claims are also allowable for the same reasons set forth above.

In light of the amendments and remarks above, Applicant submits that all rejections are now overcome. The application is now in condition for allowance and expeditious notice thereof is earnestly solicited. Should the Examiner have any questions or comments which would place the application in better condition for allowance, the Examiner is respectfully requested to call the undersigned attorney.

Respectfully submitted,



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